REMARKS

Restriction Requirement

The Restriction Requirement states that restriction to one of the following inventions is required under 35 U.S.C. 121:

I)   Claims 1-5 and 10-11, drawn to radioactive magnetic fluids, classified in class 600, subclass 4.

II)   Claims 6-9, drawn to the process for preparing magnetic nanoparticles, classified in class 427, subclass 127.

Discussion Of Telephone Interview

Applicants express appreciation for the courtesies extended by the Examiner during a telephone interview on April 25, 2006 and the Examiner's telephone message of April 26, 2006 to Applicants' representative Arnold Turk.   During the telephone interview, it was noted that the Office Action alleged that the Declaration was defective; however, the Declaration included the information regarding the foreign application that was noted in the assertion of a defective Declaration.   During the April 25, 2006 telephone interview, the Examiner indicated that the claims of priority must also be checked in the Declaration to which it was argued that the claim of priority can be in the Declaration, but can also be in a separate paper.   The Examiner indicated that she would check on this and call back.

In the telephone message of April 26, 2006, the Examiner indicated that the Declaration was not defective, and no action need be taken by Applicants with the submission of a new Declaration.

Response To Assertion Of Defective Oath

As noted in the discussion of the telephone interview above, the Examiner has indicated that Applicants' Declaration is not defective in that the appropriate foreign application information is included therein, the claim can be stated in a separate paper, and no action need be taken with respect to submission of a new Declaration. In this regard, Applicants have filed claims of priority when filing the application and with the submission of the certified copy on November 6, 2003. In fact, the Office Action confirms the claims of priority and receipt of the certified copy.

Applicants further note that a Supplemental Application Data Sheet is being submitted on even date herewith which also includes the foreign application information and priority claim.

Election

In order to be responsive to the restriction requirement, Applicants elect the invention of Group I, claims 1-5 and 10-11, with traverse.

REMARKS

Notwithstanding the election of the claims of Group I to be responsive to the Restriction Requirement, Applicants respectfully traverse the Examiner's requirement for restriction.

Initially, it is noted that the requirement for restriction omits one of the two criteria of a proper requirement as now established by U.S. Patent and Trademark Office policy, as

set forth in MPEP 803, viz. that "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if a restriction were not required. Due to the aforementioned omission, it is respectfully submitted that the requirement for restriction is improper and, consequently, its withdrawal is respectfully requested.

Related to this, the requirement is traversed since there would not appear to be a serious burden to examine Applicants' claims in total, and for which the appropriate claim fees have been paid. Applicants submit that it would be no serious burden on the Examiner to examine all of the pending claims, because a search for all of the claims in the above-identified application, should be made in order to do a complete and thorough search in view of the recognized relationship between the claims in Groups I and II, as stated in the Office Action.

Furthermore, as the Examiner appreciates, in order to justify a requirement for restriction the difference between the inventions defined by the various groups of claims must be material. Despite this requirement, although the requirement has characterized the noted difference as being material, the requirement has not stated or offered a definition of what is "materially different" to justify a requirement for restriction, or offered an explanation as to why the mentioned differences are material for restriction requirement purposes.

Absent a definition or explanation of this concept, it is respectfully submitted that although the requirement has alleged that the process recited in claims 6-9 does not make radioactive nanoparticles while referring to the radioactive Cu of Group I, the requirement has not established that any such alleged differenced is materially different for supporting a requirement for restriction, including the undue burden requirement as discussed above.

Moreover, the claims have been amended herein so that the claims of Group II depend upon claim 1 of Group I, and claim 6 has been amended to recite preparing the magnetic nanoparticles of $Cu_xFe_{1-x}O \cdot Fe_2O_3$ by coprecipitating components of Fe^{2+} and Fe^{3+} with a component of radioactive Cu^{2+} under the presence of precipitator. Accordingly, for this additional reason, there should be no undue burden to examine each of the pending claims.

Still further, claim 6 has been amended to avoid the use of step language.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.
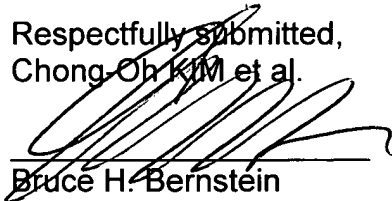
CONCLUSION

For the reasons discussed above, it is respectfully submitted that the requirement for restriction is improper and should be withdrawn.

Withdrawal of the requirement for the restriction with the examination of all claims pending in this application is respectfully requested.

Favorable consideration with early allowance of the pending claims is most earnestly requested.

If the Examiner has any questions, or wishes to discuss this matter, please call the undersigned at the telephone number indicated below.

Respectfully submitted,
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